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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/471,357

12/23/1999

SHINJI NABESHIMA

2406-3

7310

7590

06/15/2005

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EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/471,357

Applicant(s)

NABESHIMA ET AL.

Examiner

Vincent F. Boccio

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE 5/12/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11-18, 21-58 and 65-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 19, 20 and 59-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

***Response to Arguments***

1. Applicant's arguments filed against non-amended claims 19, 20, 62, 63, 64 fully considered but they are not persuasive. {A} In re page 27-28, applicant states, the art applied to the claims fails to disclose "transmitting a first and second sets one for reproduction and one for rendering or not in reproduction.

In response as stated previously, Butler does disclose wherein a transmitter that transmits, such that, PAGE 5, COL. 1, PARA [0055], "OVERLAYS CAN BE DISPLAYED AT THE TIMES INDICATED BY THE TIMING SPECIFICATIONS CONTAINED IN THE CONTROL DATA", WHICH IS ONE RENDERRING MODE, ALTERNATIVELY, ANTICIPATES, THAT, ANOTHER MODE, "RATHER THAN AT THE TIME THEY ARE Received", therefore, another mode without timings during rendering, while the playback or reproduction mode of operation, the timing specification is used, therefore, at least two different modes, when rendering when received, another, playback using timings to trigger, further the third using timings when rendering and another at page 4 col. 2, triggered to occur based upon when the actors on the screen enunciate certain words that serve as reference marks, therefore more than one interactive mode is anticipated by the reference, either for rendering and reproduction operations, therefore, rendering and reproduction modes of operation, wherein the control content depending on the mode can be different, by having or not having timings or other with respect to the media stream, for triggering overlays, when rendering trigger overlays, as received, upon a reproduction operation, based on a specific timing indicated by the timing specifications contained in the control data.

2. Applicant's arguments with respect to amended claims 10, 59, 60, 61 have been considered but are moot in view of the new ground(s) of rejection.

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 19, 20, 62, 63, 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493, FD 7/1997).

The examiner incorporates by reference the previous action against the claims.

3. Claims 10, 59, 60, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493, FD 7/1997), as applied above and further in view of Gerba et al. (5,931,908).

The examiner incorporates by reference the previous action against the claims, but the claims have been amended to further recite,

Wherein the "recording environment information being generated and recorded in a record medium by a receiver when the receiver records the content data."

Wherein the control content, represent the overlay interactive data and the content being video and audio data,

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wherein the control content is overlay-ed with respect to the video content.

Regarding claims 10, 59, 60, 61 as amended, Butler fails to particularly disclose,

O "recording environment information being generated and recorded in a record medium by a receiver when the receiver records the content data, because, Butler seems to suggest providing pre-recorded media or recording, wherein the overlays and timings would be stored other than when the content video is received.

The examiner cites Gerba, col. 10, "combined signal by the signal combiner 10 may be stored in 20, for later transmission from the head end 2 .... Alternatively, the combined signal by the combiner 10 may be transmitted to the remote user location ... then stored in ... media recording/playback 54", as taught by Gerba.

Therefore, it would have been obvious to those skilled in the art at the time of the invention to modify Butler, to transmit from the source a composite signal to be recorded by a user, to media at the same time, wherein the content or video is recorded or receive, with the recording environment or interactive, being on the same transmission, therefore, received processed and stored at the same time, as taught by the art applied.

Contact Fax Information

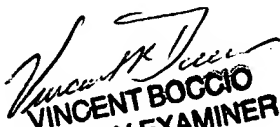
Any response to this action should be faxed to:

(703) 872-9306, (for communication intended for entry)

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent  
6/12/05

  
VINCENT BOCCIO  
PRIMARY EXAMINER